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EXAMINER
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MYHRE, JAMES W

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 04/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/523,283

**Applicant(s)**

MILLER ET AL.

**Examiner**

James W Myhre

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15-29 and 32-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-13 is/are allowed.
- 6) ☒ Claim(s) 15-29 and 32-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 14, 2004 has been entered.

### ***Response to Amendment***

2. The preliminary amendment filed on September 14, 2004 is sufficient to overcome the previous rejection in view of Donohue et al (5,987,480), Rapaport et al (5,890,152), and Griebenow et al (5,850,520) references. The amendment amended Claims 1, 2, 15, 16, 19, 32, and 33. No new claims were entered by this amendment. Claims 14, 30, and 31 were previously canceled. Thus, the currently pending claims considered below are Claims 1-13, 15-29, and 32-37.

### ***Claim Objections***

3. Claim 37 is objected to because of the following informalities: the claim is annotated as Original and has a period after the first three lines. However, three additional lines reciting types of print consumables have been added. The Examiner

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believes that the addition of these three lines was a typographical error and were unintentionally added. The claim will be considered without the additional three lines. Appropriate correction is required.

***Allowable Subject Matter***

4. Claims 1-13 are allowed.

***Examiner's Statement of Reasons for Allowance***

5. The following is an examiner's statement of reasons for allowance:

Prior art was found which disclosed a document delivery system which stored a plurality of content objects and selectively retrieved at least some of the stored content objects to construct a customized publication based at least in part on a user profile of the requesting user (Donohue et al; 5,987,480, col 4, lines 16-34; col 5, lines 63-67; col 7, lines 35-47; col 8, lines 10-13; and col 11, lines 21-25). Prior art was also found which disclosed a layout manager for selecting the appropriate template (layout) to use when generating a customized publication for the user (Donohue et al; col 5, lines 24-67). However, prior art was not found which also disclosed that the layout manager would maintain a record of time required to complete at least a partial layout of the publication which would be used to estimate the time required to layout and complete future publications as in the newly entered limitation of Claim 1. Thus, the Examiner considers the maintenance and use of a record of layout times for customized publications to be the non-obvious novelty of the present invention over the prior art.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 15-18, 24, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donohue et al (5,987,480) in view of Griebenow et al (5,850,520).

Claim 15: Donohue discloses a method for generating a customized publication, comprising:

- a. receiving and storing a plurality of content objects from one or more content providers (col 7, lines 35-47 and col 8, lines 10-13); and
- b. generating a customized publication from the stored content objects based at least in part on a user profile of the requesting user (col 4, lines 16-34; col 5, lines 63-67; and col 11, lines 21-25).

While Donohue further discloses registering the users which gives them "special treatment such as discount prices" (col 4, lines 26-30), it is not explicitly disclosed that the earned royalties, advertising rates, and other agreements would be maintained.

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However, Griebenow discloses a similar method for delivering a document over the Internet which also discloses the content manager (publisher) charging the content provider (advertiser) for presenting the content provider's content to the user (col 9, lines 47-48 and col 10, lines 6-10 and 25-27). Official Notice is also taken that it is old and well known for publishers to have contractual obligations with content providers (advertisers and authors) to either charge (advertising fees) or pay (royalties) the content providers for publishing their content. For example, in the newspaper industry a newspaper publisher usually has set advertising rates it charges advertisers for publishing advertisements in the newspaper and set fees (royalties) that it will pay freelance reporters (and other news agencies) to publish their news items, stories, etc. in the newspaper. The newspaper will also charge the users (readers) a small fee to read (purchase) the newspaper once it is published. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to manage the normal contractual obligations of users and content providers of Donohue's document delivery system. One would have been motivated to manage such contractual obligations in order to maintain the financial viability of the publishing system.

Claim 16: Donohue and Griebenow disclose a method for generating a customized publication as in Claim 15 above, and Donohue further discloses periodically publishing and distributing the customized publication in accordance with content provider usage criteria (col 10, lines 2-23 and 43-48 and col 11, lines 21-25). It

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is further obvious that the contractual obligations will be checked and complied with periodically, such as after each publication run. While it may theoretically be possible to process separate billings for a document containing an advertisement delivered to 10,000 readers (users) in real time (e.g. bill an advertiser a tenth of a cent when a document containing his advertisement is delivered to a user), it would be inane to process 10,000 one-tenth cent billing transactions for delivering an advertisement embedded in today's newspaper to 10,000 users when only one transaction would be needed to bill the advertiser the \$100. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to periodically check and comply with the contractual obligations in Donohue. One would have been motivated to check and comply with the obligations periodically in order to decrease the amount of time and bandwidth needed to process an excessive number of transactions as discussed above.

Claims 17 and 18: Donohue and Griebenow discloses a method for generating a customized publication as in Claim 16 above, but do not explicitly disclose the content provider limiting the publishing of their content based on the publishing of content from another content provider, such as a competitor. Official Notice is taken that it is old and well known within the marketing arts for content providers to place limitations on when, how, and where their content can be published. One of the well known limitations is the proximity to other similar or competing content. For example, an advertiser for an alcohol product would not desire the advertisement to be published with an article

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directed towards the problems of drunk driving; nor would a tobacco producer want to advertise their product next to an article about the detrimental effects of cigarette smoke. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to allow the content provider to place limitations as to the publishing of their content in respect to other content objects or competitors' content objects. One would have been motivated to allow such limitations in order to prevent conflicting content of being published together.

Claim 24: Donohue and Griebenow disclose a method for generating a customized publication as in Claim 15 above, but do not explicitly disclose using a non-invasive marking wrapper to uniquely identify and distribute the document. Official Notice is taken that it is old and well known to use wrappers to protect and to distribute documents, such as newspapers and magazines, and to place unique identifying indicia onto the wrapper (e.g. names and address of subscriber) to facilitate the distribution of the document. For example, the National Geographic magazine is distributed using a plain brown wrapper upon which the subscriber's name and address is printed, along with text and graphics identifying the publication and other information. The Examiner has been receiving this magazine wrapped in this manner for approximately 8 years. Furthermore, an electronic document sent to a subscriber is usually encapsulated in an email message that not only identifies the subscriber and distribution data (email address), but also includes a title or subject line to identify the document enclosed or attached to the email message. Another well-known feature that email services provide



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is a "return receipt" option in which the sender may select to receive notification when the recipient has received (and/or opened) the email as discussed by Rapaport (see the rejection of Claims 8, 20, 22, 26, 27, and 35 below). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to wrap the document in Donohue in a non-invasive marking wrapper which uniquely identifies the document and which can be used to distribute the document and then to use the well-known return receipt feature of email systems to track the user's receipt and disposition of the document. One would have been motivated to use such a wrapper and tracking steps in view of Donohue's disclosure that the system will receive and store the user's Internet address and email address (col 10, lines 20-23 and 31-34) and then use such information to deliver a customized document to that user.

Claim 25: Donohue and Griebenow discloses a method for generating a customized publication as in Claim 24 above, and Donohue further discloses distributing the document through an electronic delivery system (e.g. the Internet)(col 7, lines 25-34).

8. Claims 19-23 and 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donohue et al (5,987,480) in view of Griebenow et al (5,850,520) and in further view of Rapaport et al (5,890,152).

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Claims 19, 20, and 22: Donohue and Griebenow discloses a method for generating a customized publication as in Claim 16 above, and Donohue further discloses distributing the document through an electronic delivery system (e.g. the Internet)(col 7, lines 25-34). Rapaport discloses a similar method for distributing a document over the Internet, and further discloses virtual sensors that will monitor and report the receipt and usage of the document by the user. For example, Rapaport discloses sensing "how long the user is looking at the section of the media file segment, if the sound/video file is being accessed repeatedly, how fast is a scroll bar progressing on a text file segment, or is the media file segment printed, saved, or listened to" (col 12, lines 1-5). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to monitor and report the distribution, receipt, and user disposition of the customized document in Donohue. One would have been motivated to track this type of information in order to provide more meaningful updates to the user's profile by determining if the content object is of interest to the user as discussed by the references and also to provide an effective way of determine the charges or payments accrued by the document delivery system.

Claim 21: Donohue, Griebenow, and Rapaport disclose a method for generating a customized publication as in Claim 20 above, and Donohue further discloses updating the user profile based on the received information (col 7, line 49 – col 8, line 8).

Claim 23: Donohue, Griebenow, and Rapaport disclose a method for generating a customized publication as in Claim 20 above, and Griebenow further discloses initiating a financial transaction (charging) between the content manager (publisher) and one or more of the content providers (advertisers) based on the collected monitoring data (col 9, lines 47-48 and col 10, lines 6-10 and 25-27). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to initiate financial transactions between the content manager and one or more content providers in Donohue. One would have been motivated to conduct such financial transactions in order to make the system financially viable by allowing the content manager to be paid by advertising content providers for inclusion of their advertisements as in common in the publishing industry.

Claims 26 and 27: Donohue and Griebenow disclose a method for generating a customized publication as in Claim 25 above, and Donohue further discloses distributing the document through an electronic delivery system (e.g. the Internet)(col 7, lines 25-34). Rapaport discloses a similar method for distributing a document over the Internet, and further discloses virtual sensors that will monitor and report the receipt and usage of the document by the user. For example, Rapaport discloses sensing "how long the user is looking at the section of the media file segment, if the sound/video file is being accessed repeatedly, how fast is a scroll bar progressing on a text file segment, or is the media file segment printed, saved, or listened to" (col 12, lines 1-5). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention

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was made to monitor and report the distribution, receipt, and user disposition of the customized document in Donohue. One would have been motivated to track this type of information in order to provide more meaningful updates to the user's profile by determining if the content object is of interest to the user as discussed by the references and also to provide an effective way of determine the charges or payments accrued by the document delivery system.

Claim 28: Donohue, Griebenow, and Rapaport disclose a method for generating a customized publication as in Claim 26 above, and Griebenow further discloses initiating a financial transaction (charging) between the content manager (publisher) and one or more of the content providers (advertisers) based on the collected monitoring data (col 9, lines 47-48 and col 10, lines 6-10 and 25-27). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to initiate financial transactions between the content manager and one or more content providers in Donohue. One would have been motivated to conduct such financial transactions in order to make the system financially viable by allowing the content manager to be paid by advertising content providers for inclusion of their advertisements as in common in the publishing industry.

Claim 29: Donohue, Griebenow, and Rapaport disclose a method for generating a customized publication as in Claim 26 above, and Donohue further discloses updating the user profile based on the received information (col 7, line 49 – col 8, line 8).

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9. Claims 32-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donohue et al (5,987,480) in view of Rapaport et al (5,890,152).

Claim 32: Donohue discloses a system for generating a customized publication, comprising:

- a. receiving and storing a plurality of content objects from one or more content providers (col 7, lines 35-47 and col 8, lines 10-13); and
- b. generating a customized publication from the stored content objects based at least in part on a user profile of the requesting user (col 4, lines 16-34; col 5, lines 63-67; and col 11, lines 21-25).

Rapaport discloses a similar system for distributing a document over the Internet, and further discloses virtual sensors that will monitor and report the receipt and usage of the document by the user. For example, Rapaport discloses sensing "how long the user is looking at the section of the media file segment, if the sound/video file is being accessed repeatedly, how fast is a scroll bar progressing on a text file segment, or is the media file segment printed, saved, or listened to" (col 12, lines 1-5). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to monitor and report the distribution, receipt, and user disposition of the customized document in Donohue. One would have been motivated to track this type of information in order to provide more meaningful updates to the user's profile by determining if the content object is of interest to the user as discussed by the references and also to provide an effective way of determine the charges or payments accrued by the document delivery system.

While Donohue and Rapaport disclose using and updating a user profile based on tracked information about the user's habits, preferences, demographics, etc., it is not explicitly disclosed that information will be received from the user's printer which includes at least one of total ink usage, ink usage by color, and printable media (i.e. paper) usage. However, Official Notice is taken that such monitoring of printers is old and well known within the printing arts. The Examiner has attached several references (listed in the Conclusion paragraph below) which disclose that various methods for performing such monitoring and reporting were known from at least 1990 onwards. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to perform such monitor and report such data in Donohue. One would have been motivated to perform the monitoring and tracking of the user's printer in order to ensure that the customized document is received by the user; thus enabling the proper charges and fees to be determined for the content providers.

Claim 33: Donohue and Rapaport disclose a system for generating a customized publication as in Claim 32 above, and Donohue further discloses constructing the document based on information from a personal profile (user profile) and one or more key contributors as discussed in reference to Claims 4, 5, and 13 above. While it is not explicitly disclosed that the user profile or key contributors include one or more of a season of publication, a geographic location of the requesting user, the document server features or limitations, or the content provider usage criteria, it would have been obvious to include at least the geographic location of the requesting user as part of the

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user demographics in the user's profile. It also would have been obvious to use the current time of the year (i.e. season) to determine the desirability of the content object, such as presenting a content object about ski resorts during the winter instead of during the spring or summer. As discussed above in the previous office action in reference to Claims 12, 17, and 18, it would have also been obvious to taken into account any limitations or usage (targeting) criteria designated by the content provider, such as distributing an advertising content object only between the start and end dates of a promotional campaign as indicated by the content provider. One would have been motivated to use one or more of these criteria when compiling the document to distribute in order to provide a document which is more pertinent to the user.

While it is not explicitly disclosed that the advertising content object sent to the user is for a print consumable, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select such an advertisement. One would have been motivated to select an advertisement for a print consumable in view of the user profile containing such information as discussed above and in view of Donohue's disclosure of sending a targeted advertisement based on the user profile.

Claim 34: Donohue and Rapaport disclose a system for generating a customized publication as in Claim 32 above, but do not explicitly disclose using a non-invasive marking wrapper to uniquely identify and distribute the document. Official Notice is taken that it is old and well known to use wrappers to protect and to distribute documents, such as newspapers and magazines, and to place unique identifying indicia

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onto the wrapper (e.g. names and address of subscriber) to facilitate the distribution of the document. For example, the National Geographic magazine is distributed using a plain brown wrapper upon which the subscriber's name and address is printed, along with text and graphics identifying the publication and other information. The Examiner has been receiving this magazine wrapped in this manner for approximately 8 years. Furthermore, an electronic document sent to a subscriber is usually encapsulated in an email message that not only identifies the subscriber and distribution data (email address), but also includes a title or subject line to identify the document enclosed or attached to the email message. Another well-known feature that email services provide is a "return receipt" option in which the sender may select to receive notification when the recipient has received (and/or opened) the email as discussed by Rapaport (see the rejection of Claims 8, 20, 22, 26, 27, and 35 below). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to wrap the document in Donohue in a non-invasive marking wrapper which uniquely identifies the document and which can be used to distribute the document and then to use the well-known return receipt feature of email systems to track the user's receipt and disposition of the document. One would have been motivated to use such a wrapper and tracking steps in view of Donohue's disclosure that the system will receive and store the user's Internet address and email address (col 10, lines 20-23 and 31-34) and then use such information to deliver a customized document to that user.



Claim 35: Donohue and Rapaport disclose a system for generating a customized publication as in Claim 34 above, and Rapaport further discloses virtual sensors that will monitor and report the receipt and usage of the document by the user. For example, Rapaport discloses sensing "how long the user is looking at the section of the media file segment, if the sound/video file is being accessed repeatedly, how fast is a scroll bar progressing on a text file segment, or is the media file segment printed, saved, or listened to" (col 12, lines 1-5). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to monitor and report the distribution, receipt, and user disposition of the customized document in Donohue. One would have been motivated to track this type of information in order to provide more meaningful updates to the user's profile by determining if the content object is of interest to the user as discussed by the references and also to provide an effective way of determine the charges or payments accrued by the document delivery system.

Claim 36: Donohue and Rapaport disclose a system for generating a customized publication as in Claim 35 above, and Donohue further discloses updating the user profile based on the received information (col 7, line 49 – col 8, line 8).

10. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Donohue et al (5,987,480) in view of Rapaport et al (5,890,152) and in further view of Griebenow et al (5,850,520).

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Claim 37: Donohue and Rapaport disclose a system for generating a customized publication as in Claim 35 above, but do not explicitly disclose initiating a financial transaction between the content manager and one or more of the content providers. However, Griebenow discloses a similar system for delivering a document on the Internet and further discloses initiating a financial transaction (charging) between the content manager (publisher) and one or more of the content providers (advertisers) based on the collected monitoring data (col 9, lines 47-48 and col 10, lines 6-10 and 25-27). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to initiate financial transactions between the content manager and one or more content providers in Donohue. One would have been motivated to conduct such financial transactions in order to make the system financially viable by allowing the content manager to be paid by advertising content providers for inclusion of their advertisements as in common in the publishing industry.

### ***Response to Arguments***

11. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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a. Hillman et al (5,365,312) discloses a system and method for monitoring and reporting print consumables.

b. Acquaviva et al (5,459,556) discloses a system and method for monitoring and reporting print consumables.

c. Maruyama et al (5,635,972) discloses a system and method for monitoring and reporting print consumables.

d. Christensen et al(5,682,140) discloses a system and method for monitoring and reporting print consumables.

e. Hirose et al(6,084,554) discloses a system and method for monitoring and reporting print consumables.

f. Kanaya et al (6,223,131) discloses a system and method for monitoring and reporting print consumables.

g. Shoff et al(6,240,555) discloses a system and method for using layout to generate a customized document (video program) and for timing the generation based on user defined periods.

h. Rock, JR., et al (US2004/0111326) discloses a system and method for automatically monitoring and ordering print consumables.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached Monday through Thursday from 6:30 a.m. to 3:30 p.m.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9306. Draft or Informal faxes, which will not be entered in the application, may be submitted directly to the examiner at (703) 746-5544.

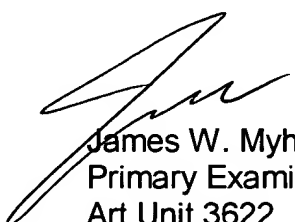
Note: Effective April 2005, the examiner's telephone numbers will be changed to (571) 272-6722 (phone) and (571) 273-6772 (Informal faxes); and the examiner's supervisor's telephone number will be changed to (571) 272-6724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.



JWM

March 29, 2005



James W. Myhre  
Primary Examiner  
Art Unit 3622